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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,192	07/18/2003	Bruce M. Ruana	RUANA-001CIC	2668

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EXAMINER	
MAYO, TARA L	

ART UNIT	PAPER NUMBER
3671	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/623,192	RUANA, BRUCE M.	
	Examiner	Art Unit	
	Tara L. Mayo	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-25,27-50,52-73 and 75-101* is/are pending in the application.

4a) Of the above claim(s) *8-22,32-46,57-71,80-94 and 102-105* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7,23-25,27-31,47-50,52-56,72,73,75-79 and 95-101* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 July 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 July 2006 has been entered.

Drawings

2. The drawings were received on 11 July 2006. These drawings are acceptable.

Specification

3. The amendment filed 13 June 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: on page 12 at paragraph 44, expanded vinyl *and* vinyl with a layer of foam. Specifically, the proposed amendments to the Specification filed after final rejection were not entered by the Examiner and were not requested by Applicant to be entered with the filing of the RCE dated 11 July 2006.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 23 through 26, 47 through 51, 72 through 74 and 95 through 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1) in view of Shomo (U.S. Patent No. 4,660,832).

Kobe et al. '382, as seen in Figures 1 and 8, disclose a system for providing a grip (20) for a hand rail or grab bar (col. 14, lines 36 through 37) having an outer surface, the grip comprising:

with regard to claims 1, 25, 48, 96 and 97,

a skin layer (21) axially wrapped (col. 11, lines 44 through 46) about the outer surface of the hand rail or grab bar and having a top surface (24) and a bottom surface (25);

a stretchable material (22; col. 4, lines 16 through 17 and 25 through 41) having a top surface and a bottom surface opposite said top surface, said top surface adhered to said bottom surface of said skin layer;

a releasable adhesive (34; col. 4, lines 54 through 56) disposed on said bottom surface of said stretchable material, said releasable adhesive configured to adhere to the outer surface;

with regard to claims 24 and 49,

wherein the grip substantially covers the outer surface; and

with regard to claim 26,

wherein said skin layer comprises a distance between said top surface and said bottom surface, said distance being variable.

Kobe et al. '382 is silent as to whether the edges of the wrapped skin layer overlap.

Shomo '832, as best seen in Figure 3, teaches a grip comprising:

a hand railing (13a) having an outer surface, a length and cross-sectional circumference

a skin layer (17a) having a top surface, a bottom surface, a first end, and a second end opposite said first end, wherein said top surface is continuous and flat from said first end to said second end;

a 4-way stretchable material layer (16a) with a stretchable top surface and a stretchable bottom surface wherein said 4-way stretchable material comprises polyester (col. 5, lines 44 through 46), said top surface of said stretchable layer adhered to said bottom surface of said skin layer (col. 5, lines 35 through 37); and

an adhesive disposed on said bottom surface of said 4-way stretchable layer.

Shomo '832 expressly teaches the skin layer having non-overlapping edges as preferred for reducing vibration (column 6, lines 57 through 68).

It would have been obvious to one having ordinary skill in the art at the time of invention to modify the device disclosed by Kobe et al. '382 such that the edges of the wrapped skin layer

would not overlap as taught by Shomo '832. The motivation would have been to reduce the transmission of vibration to a person's hand during use.

With regard to claims 50, 51, 73, 74 and 98 through 101, the method steps recited therein are inherent to the method of making and/or assembling the device taught by the combination of Kobe et al. '382 and Shomo '832.

With specific regard to claims 23, 47 and 72, Kobe et al. '382 expressly teach the possibility of multiple backing layers (col. 2, lines 39 through 42, and col. 4, lines 5 through 8).

With regard to claim 23, it would have been obvious to one having ordinary skill in the art of grips at the time the invention was made to further modify the device disclosed by the combination of Kobe et al. '382 and Shomo '832 such that it would include a backing layer. The motivation would have been to reinforce the skin layer.

With regard to claims 47, 72 and 95, the method steps recited therein are inherent to the method of making and/or assembling the device taught by the combination of Kobe et al. '382 and Shomo '832 as modified above by the teaching for an alternative embodiment in Kobe et al. '382.

6. Claims 3, 4, 7, 27, 28, 31, 52, 53, 56, 75, 76 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1) in view of Shomo (U.S. Patent No. 4,660,832) as applied to claims 1, 25, 50 and 73 above, and further in view of Oseroff et al. (U.S. Patent No. 3,848,480).

The combination of Kobe et al. '382 and Shomo '832 discloses all of the features of the claimed invention with the exception(s) of:

with regard to claims 3, 27, 52 and 75,

a light emitter coupled with the top surface of the skin layer;

with regard to claims 4, 28, 53 and 76,

the light emitter being a material selected from the group consisting of phosphorescent chemicals, low grade radiant materials, electrically stimulated phosphorescent material, reflective materials, and luminescent pigments; and

with regard to claims 7, 31, 56 and 79,

the light emitter being activated in the absence of light.

Oseroff et al. '480, as seen in Figures 1 through 6, disclose a grip for a grab bar comprising a phosphorescent material (col. 5, lines 35 through 42) to serve as a luminous safety feature in the dark.

With regard to claims 3, 4, 7, 27, 28 and 31, it would have been obvious to one having ordinary skill in the art of grips at the time of invention to further modify the grip disclosed by the combination of Kobe et al. '382 and Shomo '832 with a phosphorescent material as taught by Oseroff et al. '480. The motivation would have been to provide a luminous safety feature.

With regard to claims 52, 53, 56, 75, 76 and 79, the method steps recited therein are inherent to the method of making the device taught by the combination of Kobe et al. '382, Shomo '832 and Oseroff et al. '480.

7. Claims 3, 5, 27, 29, 52, 54, 75 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1) in view of Shomo (U.S. Patent No. 4,660,832) as applied to claims 1, 25, 50 and 73 above, and further in view of McCalla et al. (U.S. Patent No. 6,364,500 B1).

The combination of Kobe et al. '382 and Shomo '832 discloses all of the features of the claimed invention with the exception(s) of:

with regard to claims 3, 27 and 75,

a light emitter coupled with the top surface of the skin layer; and

with regard to claims 5, 29 and 77,

the light emitter being selected from the group consisting of fiber optics and light emitting diodes.

McCalla et al. '500, as seen in Figure 6, show a handle member (20) comprising fiber optics for directing light through the handle member (col. 3, lines 13 through 26).

With regard to claims 3, 5, 27 and 29, it would have been obvious to one having ordinary skill in the art of grips at the time of invention to further modify the device taught by the combination of Kobe et al. '382 and Shomo '832 such that it would include fiber optics as taught

to be desirable by McCalla et al. '500. The motivation would have been provide the skin layer with means for illumination.

With regard to claims 52, 54, 75 and 77, the method steps recited therein are inherent to the method of making and/or assembling the device taught by the combination of Kobe et al. '382 and Shomo '832 as further modified above by McCalla et al. '500.

8. Claims 3, 6, 27, 30, 52, 55, 75 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,610,382 B1) in view of Shomo (U.S. Patent No. 4,660,832) as applied to claims 1, 25, 50 and 73 above, and further in view of Bixler et al. (U.S. Patent No. 5,251,903).

The combination of Kobe et al. '382 and Shomo '832 discloses all of the features of the claimed invention with the exception(s) of:

with regard to claims 3, 27 and 75,

a light emitter coupled with the top surface of the skin layer; and

with regard to claims 6, 30 and 78,

the light emitter being configured to activate responsive to pressure.

Bixler et al. '903, as seen in Figures 1 through 4, show a ball (10) comprising a skin layer cover (12) having an illumination means (col. 3, lines 23 through 26) which is activated by pressure for warning of an improper grip.

With regard to claims 3, 6, 27 and 30, it would have been obvious to one having ordinary skill in the art of grips at the time of invention to further modify the device taught by the combination of Kobe et al. '382 and Shomo '832 such that it would include a pressure activated light emitter as taught by Bixler et al. '903. The motivation would have been to provide the grip with a means for indicating contact with a user's hand as desired.

With regard to claims 52, 55, 75 and 78, the method steps recited therein are inherent to the method of making and/or assembling the device taught by the combination of Kobe et al. '382 and Shomo '832 as further modified above by Bixler et al. '903.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 25, 96 and 97 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 14 of U.S. Patent No. 6,775,937 in view of Shomo (U.S. Patent No. 4,660,832).

U.S. Patent No. '937 fails to positively recite:

a hand rail or grab bar; and

the skin layer being continuous and flat.

Shomo '832, as best seen in Figure 3, teaches a grip comprising:

a hand railing (13a) having an outer surface, a length and cross-sectional circumference

a skin layer (17a) having a top surface, a bottom surface, a first end, and a second end opposite said first end, wherein said top surface is continuous and flat from said first end to said second end;

a 4-way stretchable material layer (16a) with a stretchable top surface and a stretchable bottom surface wherein said 4-way stretchable material comprises polyester (col. 5, lines 44 through 46), said top surface of said stretchable layer adhered to said bottom surface of said skin layer (col. 5, lines 35 through 37); and

an adhesive disposed on said bottom surface of said 4-way stretchable layer.

Shomo '832 expressly teaches the skin layer having non-overlapping edges as preferred for reducing vibration (column 6, lines 57 through 68).

It would have been obvious to one having ordinary skill in the art at the time of invention to make the skin layer of the patented device continuous and flat as taught by Shomo '832. The motivation would have been to provide the user with a smooth, comfortable grip.

11. Claims 1, 3, 25, 50, 73, 96 and 97 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11, 23, 34, 46, 57, 69 and 74 through 79 of copending Application No. 09/874,940. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 4-way stretchable layer of U.S. Patent Application No. '940 meets the claimed stretchable layer of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1, 25, 96 through 98 and 101 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 59, 81 and 82 of copending Application No. 10/338,145 in view of Shomo (U.S. Patent No. 4,660,832).

U.S. Patent Application No. '145 fails to positively recite:

the skin layer being continuous and flat with non-overlapping edges.

Shomo '832, as best seen in Figure 3, teaches a grip comprising:

a hand railing (13a) having an outer surface, a length and cross-sectional circumference

a skin layer (17a) having a top surface, a bottom surface, a first end, and a second end opposite said first end, wherein said top surface is continuous and flat from said first end to said second end;

a 4-way stretchable material layer (16a) with a stretchable top surface and a stretchable bottom surface wherein said 4-way stretchable material comprises polyester (col. 5, lines 44 through 46), said top surface of said stretchable layer adhered to said bottom surface of said skin layer (col. 5, lines 35 through 37); and

an adhesive disposed on said bottom surface of said 4-way stretchable layer.

Shomo '832 expressly teaches the skin layer having non-overlapping edges as preferred for reducing vibration (column 6, lines 57 through 68).

It would have been obvious to one having ordinary skill in the art at the time of invention to make the skin layer of the device of U.S. Patent Application No. '145 continuous and flat with non-overlapping edges as taught by Shomo '832. The motivation would have been to provide the user with a smooth, comfortable grip.

This is a provisional obviousness-type double patenting rejection.

13. Claims 1, 25, 96 and 97 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28 through 30 of copending Application No. 10/622,344 in view of Kobe et al. (U.S. Patent No. 6,610,382 B1).

U.S. Patent Application No. '344 fails to positively recite:

a stretchable material.

Kobe et al. '382, as seen in Figures 1 and 8, disclose a system for providing a grip (20) for a hand rail or grab bar (col. 14, lines 36 through 37) having an outer surface, the grip comprising:

with regard to claims 1, 25, 48, 96 and 97,

a skin layer (21) axially wrapped (col. 11, lines 44 through 46) about the outer surface of the hand rail or grab bar and having a top surface (24) and a bottom surface (25);

a stretchable material (22; col. 4, lines 16 through 17 and 25 through 41) having a top surface and a bottom surface opposite said top surface, said top surface adhered to said bottom surface of said skin layer;

a releasable adhesive (34; col. 4, lines 54 through 56) disposed on said bottom surface of said stretchable material, said releasable adhesive configured to adhere to the outer surface.

It would have been obvious to one having ordinary skill in the art at the time of invention to modify the grip taught by U.S. Patent Application No. '344 with a stretchable material as taught by Kobe et al. '382. The motivation would have been to include means for maintaining the structural integrity of the grip during use.

This is a provisional obviousness-type double patenting rejection.

14. Claims 1, 25, 96 and 97 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/921,057 in view of Shomo (U.S. Patent No. 4,660,832).

U.S. Patent Application No. '057 fails to positively recite:

the skin layer being continuous and flat and having non-overlapping edges.

Shomo '832, as best seen in Figure 3, teaches a grip comprising:

a hand railing (13a) having an outer surface, a length and cross-sectional circumference

a skin layer (17a) having a top surface, a bottom surface, a first end, and a second end opposite said first end, wherein said top surface is continuous and flat from said first end to said second end;

a 4-way stretchable material layer (16a) with a stretchable top surface and a stretchable bottom surface wherein said 4-way stretchable material comprises polyester (col. 5, lines 44 through 46), said top surface of said stretchable layer adhered to said bottom surface of said skin layer (col. 5, lines 35 through 37); and

an adhesive disposed on said bottom surface of said 4-way stretchable layer.

Shomo '832 expressly teaches the skin layer having non-overlapping edges as preferred for reducing vibration (column 6, lines 57 through 68).

It would have been obvious to one having ordinary skill in the art at the time of invention to make the skin layer of the device taught by U.S. Patent Application No. '057 continuous and flat with non-overlapping edges as taught by Shomo '832. The motivation would have been to provide the user with a smooth, comfortable grip.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

15. Applicant's arguments filed 11 July 2006 have been fully considered but they are not persuasive.

In response to Applicant's statement that Kobe et al. '382 fails to teach a continuous and flat skin layer, the Examiner contends that essentially the skin layer of the prior art is continuous and flat. Firstly, the skin layer is unquestionably continuous in that it is unitary. Secondly, Kobe et al. '382 expressly teach the height of the stems being so minute and the density of the stems

being so great that the same are not detectable by human touch (col. 9, lines 1 through 10). The Examiner maintains the rejection of the claims as being unpatentable over the top surface of the skin layer of the device shown by Kobe et al. '382 in view of Applicant's failure to expressly teach a flat top surface or to ascribe any criticality to the claim limitation in the Specification, and Applicant's reliance solely upon the drawings for support of the claim limitation.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 571-272-6992. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tlm
23 August 2006

TARA L MAYO
PATENT EXAMINER